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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,999	05/04/2005	Eduard Michel	2002DE142	3377
25255 7590 07/31/2008 CLARIANT CORPORATION INTELLECTUAL PROPERTY DEPARTMENT 4000 MONROE ROAD CHARLOTTE, NC 28205				
EXAMINER KHAN, AMINA S				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
07/31/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/533,999

Applicant(s)

MICHEL ET AL.

Examiner

AMINA KHAN

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 4-8 and 15-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 9-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1-3 and 9-14 in the reply filed on July 7, 2008 is acknowledged. Claims 4-8 and 15-19 are withdrawn from consideration due to a non-elected invention. Claims 1,2 and 13 have been amended.
2. The objection to the specification is withdrawn.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 and 9-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Machtold et al. (US 5,061,585).

Machtold et al. teach compounds of formula (1) and electrophotographic toner and developer compositions comprising these compounds as charge control agents (abstract; column 3, lines 1-30). Machtold et al. further teach compositions comprising these compounds as a color modifier for black, red, yellow and brown toners (column 3, lines 20-25). Machtold et al. are silent as to the aniline content and conductivity in 5% by aqueous dispersion. It would be expected that the compounds of Machtold et al. encompass the claimed aniline content and conductivity because these are inherent properties to the purified compound.

Accordingly, the teachings of Machtold et al. are sufficient to anticipate the material limitations of the instant claims.

In the alternative, if the teachings of Machtold et al. are not sufficient to anticipate the material limitations of the instant claims, these properties would be obvious as similar compounds would be expected to have similar properties.

6. Claims 1-3,9,13 and 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schafer et al. (US 3,652,602).

Schafer et al. teach dye compounds of formula (1) (column 7, lines 14-70). Schafer et al. are silent as to the aniline content and conductivity in 5% by aqueous dispersion. It would be expected that the compounds of Schafer et al. encompass the claimed aniline content and conductivity because these are inherent properties to the purified compound.

Accordingly, the teachings of Schafer et al. are sufficient to anticipate the material limitations of the instant claims.

In the alternative, if the teachings of Schafer et al. are not sufficient to anticipate the material limitations of the instant claims, these properties would be obvious as similar compounds would be expected to have similar properties.

7. Claims 1-3 and 9-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Metz et al. (US 6,168,895).

Metz et al. teach compounds of formula (1) and electrophotographic toner and developer compositions comprising these compounds as charge control agents (column 15, lines 35-65). Metz et al. further teach compositions comprising these compounds as included in yellow pigments (column 8, lines 1-5). Metz et al. are silent as to the aniline content and conductivity in 5% by aqueous dispersion. It would be expected that the compounds of Metz et al. encompass the claimed aniline content and conductivity because these are inherent properties to the purified compound. Metz et al. further teach toners with low conductivity (column 15, lines 13-16).

Accordingly, the teachings of Metz et al. are sufficient to anticipate the material limitations of the instant claims.

In the alternative, if the teachings of Metz et al. are not sufficient to anticipate the material limitations of the instant claims, these properties would be obvious as similar compounds would be expected to have similar properties.

Response to Arguments

8. Applicant's arguments filed regarding Machtold, Schafer and Metz have been fully considered but they are not persuasive. In applicant's declaration dated July 7, 2008 no experimental data regarding the concentration of aniline of the dye compounds of formula (I) have been provided. Applicant's arguments are speculative and have not adequately demonstrated that the instantly claimed aniline levels were not achieved in the dyes of Machtold, Schafer and Metz. Applicants' arguments are conclusory statements not supported by factual evidence, see *In re Lindner*, 457 F.2d 506, 173 USPQ 356 (CCPA 1972). Accordingly, the rejections as relied upon above are maintained.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMINA KHAN whose telephone number is (571)272-5573. The examiner can normally be reached on Monday through Friday, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lorna M Douyon/
Primary Examiner, Art Unit 1796

/Amina Khan/
Examiner, Art Unit 1796
July 29, 2008

